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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,932	11/26/2003	Dieter Horstmann	10537/276	9642

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NEW YORK, NY 10004

EXAMINER

BLAKE, CAROLYN T

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/722,932

Applicant(s)

HORSTMANN ET AL.

Examiner

Carolyn T Blake

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.  
4a) Of the above claim(s) 1, 10, 16 and 17 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-9 and 13-15 is/are rejected.  
7) ☒ Claim(s) 8 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I in the reply filed on December 23, 2004 is acknowledged. The traversal is on the ground(s) that claims 14 and 17 are linking claims. Applicants' arguments are not persuasive. Claim 1 can still be performed by a different method, for example the tool could be monitored by a camera or visual inspection.

Claims 10-12, 16, and 17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

If any of the linking claims are allowed and there is compliance with 35 USC 101 and 35 USC 112, rejoinder will be permitted in accordance with *In re. Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995). See MPEP 608.01(n).

The requirement is still deemed proper and is therefore made FINAL.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "1" has been used to designate both the shank and tool 1.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "2" has been used to designate both the tool section and tool 2.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "3" has been used to designate both the cavity and tool 3.

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5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "4" has been used to designate both the predetermined breaking point and tool 4.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "5" has been used to designate both the monitoring device and tool 5.

7. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

8. Claim 8 objected to because line 2 reads "configured as a blanking punch as a trimming tool" while it should likely read - -configured as a blanking punch or as a trimming tool- -. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3-9, and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Scott (3,728,919).

Regarding claim 1, Scott discloses a tool for at least one of cutting and noncutting treatment of a metallic component, comprising: a shank-shaped section (13) including a tool section subject to wear and a cavity (27), an arrangement (20) configured to admit a pressure medium to the cavity to monitor operability of the tool; and a monitoring device (24, 26) configured to generate a signal in accordance with a pressure change in the pressure medium.

Regarding claim 3, Scott discloses the cavity (27) includes a blind bore in the shank-shaped section (13).

Regarding claim 4, Scott discloses the tool is configured as an interchangeable unit, the arrangement configured to admit the pressure medium including an arrangement configured to admit compressed air to the cavity (27) by connecting lines.

Regarding claim 5, Scott discloses the monitoring device includes a pressure switch (26) configured to react at a preset value of a pressure change.

Regarding claim 6, Scott discloses the shank-shaped section (13) includes a predetermined breaking point. See the diameter change in FIG 2.

Regarding claim 7, Scott discloses the breaking point is configured as a local reduction in diameter at the tool section.

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Regarding claim 8, Scott discloses the tool section is configured as a blanking punch (13), the tool section including a cutting edge and a predetermined breaking point reduced in diameter relative to the shank-shaped section.

Regarding claim 9, Scott discloses the tool section includes a mandrel (15) configured to shape a metal sheet.

Regarding claim 13, Scott discloses a tool for at least one of cutting and noncutting treatment of a metallic component, comprising: a shank-shaped section (13) including a tool section subject to wear and a cavity (27); means (pressure source 20) for admitting a pressure medium to the cavity for monitoring operability of the tool; and monitoring means (24, 26) for generating a signal in accordance with a pressure change in the pressure medium.

Regarding claims 14 and 15, Scott discloses an arrangement configured to perform a method that includes admitting compressed air to a blind bore (27) in the tool; generating a signal if a preset value of a pressure change of the compressed air is exceeded in accordance with a fracture of the tool; and monitoring a function of the tool in accordance with the pressure change. See col. 2, lines 14-22.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scott. Scott fails to disclose the work piece is a cast metallic component. However, Official notice is taken it is old and well known to cut metallic components that are cast. Most metals can be cast and it is cost effective for certain manufacturing quantities because some machining operations can be eliminated. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a cast metallic work piece with the Scott device for the purpose of cost savings.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wollner (3,765,204) discloses a tool with a monitoring device.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CB

February 3, 2005



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